

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :  
Makoto HASEGAWA et al. : Group Art Unit.: 1774  
Serial No.: 09/937,099 : Examiner: GRENDZYNSKI, Michael E.  
Filed: September 20, 2001 :  
For: ADDITIVE AND INKJET RECORDING MEDIUM USING ADDITIVES

**REPLY**

Assistant Commissioner for Patents  
Washington, D.C. 20231

SIR:

In response to the Office Action mailed on December 24, 2003, applicants select, with traverse, Group II, containing claims 2-7, drawn to inkjet recording media. The traversal is on the following grounds.

MPEP § 1850 states that:

“Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).”

The claims of Group II are all dependent claims; i.e., they depend from claim 1 of Group I. Claims of both groups fall into the same category of claims, i.e., they are all product claims. Thus, consideration of unity of invention in the first place is not proper under the guidelines of the PCT and of the MPEP. Thus, the restriction requirement is not proper.

Additionally, MPEP § 1850 also states that:

“In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination

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claim avoids the prior art and the combination claim includes all the features of the subcombination.”


Thus, even additional factors such as multiple inventions claimed in dependent claims, would not affect the analysis above.

Additionally, merely alleging that the special technical feature does not define a contribution over the prior art does not establish that such special technical feature indeed does not define a contribution over the prior art. Applicants respectfully disagree with the conclusions of the Office Action.

Furthermore, the Office Action has not established that it would pose an undue burden to examine the entire scope of the claimed invention. For example, if claim 1 of Group I were examined, and allowed, the composition claims of Group II depending from claim 1 would necessarily be allowable, without any further searching burden imposed on the Patent Office.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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Filed: January 23, 2003  
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